

The opinion in support of the decision being entered today was **not** written for publication in and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL A. WRIGHT

MAILED

MAY 16 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1123
Application No. 09/766,934

ON BRIEF

Before BAHR, NAPPI, and FETTING, **Administrative Patent Judges**.

FETTING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1-4, 12 and 14-20, which are all of the claims pending in this application.

We AFFIRM IN PART.

BACKGROUND

The appellant's invention relates to automated production of sales invoices individually customized according to preferences of a client. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for providing particularized billing services, the method comprising the steps of:

selecting a client for whom a bill is to be produced, and performing the following operations within a local, expanded, or global computing environment;

extracting a list of software objects from a library of objects, each object being operative to generate a predefined bill format with specific fields for the selected client;

invoking at least one of the software objects to collect data pertinent to the client and to the specific fields in the bill format; and

producing the bill having the defined bill format, with the data collected for the selected client in the appropriate fields.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is are:

Ensel et al. (Ensel) 6,493,685 Dec. 10, 2002

Mitra et al. (Mitra) US 2001/0014878 Aug. 16, 2001

Logan et al. (Logan) US 2001/0009002 Jul. 19, 2001

Siemens EP 590332 Apr. 6, 1994
(European Patent Document)

Claim 12 stands rejected under 35 U.S.C. § 112, first paragraph, as being unpatentable for lacking enablement.

Claims 1-4 and 16-20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Mitra et al.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Logan et al.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (mailed July 13, 2005) for the examiner's reasoning in support of the rejection, and to appellant's brief (filed April 6, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Claim 12 stands rejected under 35 U.S.C. § 112, first paragraph, as being unpatentable for lacking enablement

Appellant presents no argument rebutting the examiner's rejection, but merely asserts that "Appellant respectfully disagrees."

In the absence of any evidence or specific argument proffered by the Appellant that claim 12 is properly enabled, we must sustain the rejection.

The rejection of claim 12 under 35 U.S.C. § 112, first paragraph, as being unpatentable for lacking enablement is sustained.

Claims 1-4 and 16-20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel

Claims 1-4 and 16-20 are argued collectively as a group by Appellant and accordingly we select independent claim 1 as a representative claim and will address Appellant's arguments for this group to claim 1.

Appellant argues that Ensel does not teach or suggest the creation of bill content. (See brief at page 3 and again on page 4.)

Ensel states in col. 13, lines 27-53:

With respect to the Summary 210 and E-Bill 215 data files, BAP system 200 is capable of performing the following functions: storing a predetermined amount (e.g., thirteen months) of bill data history for each biller 5; accepting manual entry/update of bill data and producing an audit trail; **receiving, editing and uploading legacy billing data files from biller 5; sending and receiving summary data; producing audit trails of all addition, change, and delete activity on files 210 and 215; extracting, reformatting, and transmitting billing data files; performing custom analysis of bill data and producing reports; and providing expandability for anticipated growth of bill and non-bill data (e.g., marketing inserts 60).** With respect to the marketing inserts 60 contained in file 235, the BAP 200 can: receive and store a predetermined amount (e.g., thirteen months) of insert history; receive, store and execute the logic required for developing and executing the conditional targeting associated with the marketing inserts 60; track a wide variety of access statistics (e.g., number read by customers 80, number responded to, types of customers 80 who responded . . .); online processing of responses from customers 80 (e.g., "I want to buy that luggage, please debit my account and send it to . . . "); and certification that an insert was read (for regulatory purposes among others). **Armed with all of the above, the BAP 200 is capable of creating an electronic bill.** (Emphasis added).

We note that these activities necessarily embrace the creation of bill content.

Therefore we conclude that Ensel does teach the creation of bill content.

Appellant argues that Ensel does not teach or suggest the customer specific formatting of bills. (See brief at page 4).

Ensel states in col. 6, lines 43-50:

As described in more detail below, it is the responsibility of the IIP 20 to reformat the billing data 55 in the format required for its own internal databases and then to format the actual published bill, statement or other information as is appropriate for the channel of distribution particular to a specific customer 80 receiving the presented bill or other information.

Although Appellant acknowledges this teaching, Appellant characterizes it as formatting specific to a channel and not to a customer.

In response, we initially note that the word “customer” is absent from claim 1. Claim 1 refers to a client instead. Appellant indicates in the arguments that the claimed client is a customer, but no such definition is apparent from the disclosure. Further, in Ensel, both the biller and the customer are clients of the intermediary service taught and claimed in Ensel. We note that claim 1 is sufficiently broad to encompass either of Ensel’s clients. Further, to the extent the customer in Ensel designates a channel, and Ensel teaches formats specific to each channel, among other formatting options, the customer is designating a format specific to that customer, albeit perhaps indirectly via the channel selection. Beyond that, Ensel teaches customer specific bill formatting provided by the data representing:

a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill, generate a paper bill if condition X occurs . . .)); presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . .); bill format preferences (e.g., send me summary only, partial details, full details . . .); reminder preferences . (Ensel, col. 10, l. 27-37).

We note that these represent instances of customer specific bill formatting.

For all of the above reasons, we conclude that Ensel does teach client specific bill formatting as claimed, and customer specific formatting as argued, but not claimed.

Appellant argues that Ensel does not teach or suggest the creation of objects. (See brief at page 5).

Ensel states in col. 10, lines 51-65:

The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file **210** are the customer's name, account number, location (address) of the bill destination, account balance, current amount due, amount past due, and minimum due. The E-Bill file **215** contains data related to the customer's current E-Bills along with historical E-Bill data which is retained for a certain period of time. The E-Bill data residing in this file **215** contains the detailed description of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller). **In a preferred embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects.**

We note that the fact that the data used for bill contents are stored as objects in an object oriented file indicates that the objects are instantiated, i.e. created or generated, when invoked. Further evidence of this is reflected at Ensel col. 13, lines 57-62:

Application 'plug-ins' residing on application server **240** accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill **215** and Summary **210** files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution.

We note that such plug-ins require an application programming interface that provides protocols that must be invoked by software that is structured as objects, whether by that name or another, further evidencing the generation of objects to collect data pertinent to the client and the bill format.

We therefore conclude that Ensel does incorporate the object generation claimed in claim 1.

Given that Ensel therefore teaches an incorporation of the elements of claim 1 in a billing structure, we must sustain the rejection, and the decision that Claims 1-4 and 16-20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel is affirmed.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens

Appellant argues that skilled artisans would not have been motivated to modify the billing system of Ensel to incorporate the translation facility of Siemens. (See brief at page 6).

While the examiner indicates that the rejection is based on Ensel in view of the Siemens patent (Answer, pages 4 and 7), the examiner merely points to teachings in the English language Derwent abstract of Siemens and does not provide an English language translation of the entire document as instructed in the Manual of Patent Examination Procedure section 706.02 (II) entitled "Reliance Upon Abstracts and Foreign Language Documents In Support of a Rejection" and section 1207.02 entitled "Contents of the Examiner's Answer." The teachings specifically alluded to by the examiner are directed broadly to simplification of communications between countries and provide no teaching or suggestion of the translation of correlated data to a selected language prior to generating the bill in a billing system. We make no determination as to whether such teaching or suggestion may be found in the Siemens patent itself as that was not the basis of the examiner's rejection.

Therefore, we find that the examiner has not established a *prima facie* case of obviousness of dependent claim 12. Accordingly, the rejection of claim 12 under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens is not sustained and the decision that claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Siemens is reversed.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Mitra et al

Appellant further argues that skilled artisans would not have been motivated to modify the billing system of Ensel to incorporate the teachings of Mitra. (See brief at page 6 and 7) .

We agree with the examiner that the billing system of Mitra complements the billing system of Ensel leading one of ordinary skill in the art to Mitra. But that is almost beside the point because the rejection does not attempt to combine Mitra's system with Ensel's. Rather, the teaching in Mitra is relied upon as evidence for the unremarkable showing that some bills of the types Ensel would prepare would be final, and may need to be identified as such. Any art in the field of billing services that generically taught the proposition that some bills are final and are identified as such would be equally persuasive as evidence that such bills tend to occur.

Accordingly we must sustain the rejection, and the decision that Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Mitra et al. is affirmed.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Logan et al

Appellant further argues that skilled artisans would not have been motivated to modify the billing system of Ensel to incorporate the teachings of Logan. (See brief at page 7).

We agree with the examiner that the billing system of Logan complements the billing system of Ensel leading one of ordinary skill in the art to Logan. But that is almost beside the point because, as with Mitra and claim 14 above, the rejection does not attempt to combine Logan's system with Ensel's. Rather, the teaching in Logan is relied upon as evidence for the unremarkable showing that some bills of the types Ensel would prepare would be duplicate, and may need to be identified as such. Any art in the field of billing services that generically taught the proposition that some bills are duplicate and are identified as such would be equally persuasive as evidence that such bills tend to occur.

Accordingly we must sustain the rejection, and the decision that Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ensel in view of Logan et al. is affirmed.

CONCLUSION

To summarize:

The decision of the examiner to reject claim 12 as being unpatentable under 35 U.S.C. § 112, first paragraph, for lack of enablement, is **affirmed**.

The decision of the examiner to reject claims 1-4 and 16-20 under 35 U.S.C. § 102(e) as being unpatentable as anticipated under Ensel is **affirmed**.

The decision of the examiner to reject claim 12 under 35 U.S.C. § 103 as being unpatentable as obvious over Ensel in view of Siemens is **reversed**.

The decision of the examiner to reject claim 14 under 35 U.S.C. § 103 as being unpatentable as obvious over Ensel in view of Mitra et al. is **affirmed**.

The decision of the examiner to reject claim 15 under 35 U.S.C. § 103 as being unpatentable as obvious over Ensel in view of Logan et al. is **affirmed**.

AFFIRMED IN PART



JENNIFER D. BAHR
Administrative Patent Judge

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